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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,263	02/01/2001	Gerard K. Kunkel	WGATE11	4319

56015 7590 01/24/2006

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EXAMINER	
BELIVEAU, SCOTT E	
ART UNIT	**PAPER NUMBER**
2614	

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/773,263	KUNKEL ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *26-28* is/are allowed.

6)☒ Claim(s) *1-25,29 and 30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse pertaining to the examiner's restriction by original presentation in the reply filed on 21 December 2005 is acknowledged. The traversal is on the ground(s) that withdrawn claims 26-28 are drawn to the digital implemental of the ad insertion module and that it would further not present an undue burden upon the Examiner to examine both digital and analog embodiments of the invention since they share many of the same features. This is found persuasive, the restriction requirement for claims 26-28 is withdrawn, and the claims are treated on their merits.

Response to Arguments

2. Applicant's arguments with respect to claims 1 and 14 have been considered but are moot in view of the new ground(s) of rejection as necessitated by applicant's amendments.

With respect to applicant's arguments such that the Sitnik reference fails to particularly teach or suggest the particular distribution of a prompt that is further embedded with the information stream, the examiner agrees and subsequently presents a new ground of rejection in light of Sitnik in order to address the missing limitation.

With respect to applicant's arguments such that the Maillard et al. reference tails to teach or suggest the particular distribution the prompt as being embedded with the information stream, the examiner respectfully disagrees. Maillard discloses that during an interactive program a logotype or message appears on the display so as to invite the user to participate (Para. [0045] and that parts of the application may be further represented by an icon (Para.

[0081]). Figure 3 illustrates the particular distribution of the broadcast application, filtering script, and broadcast filter as being set to the subscriber as part of an "information stream". Accordingly, it is the examiner's understanding that the "prompt" is embedded within the information stream such that it is provided responsive to the user meeting a particular criteria. For example, as illustrated in Figure 5, a prompt inquiring the user as to whether or nor they desire a particular discount is provided as part of the interactive application. If the user wasn't interested in the product, the prompt / interactive application would not be executed (Para. [0078]).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-4, 6, 14-19, and 25 rejected under 35 U.S.C. 102(a) as being anticipated by Maillard et al (EP 963 119 A1).

In consideration of claims 1 and 14, the Maillard et al. reference discloses a "system" and "method for transmitting information in a broadcast distribution system that is targeted to a system user" (Abstract). As illustrated in Figure 1, the system comprises a "network headend" [110/150/170], a "distribution network" [120], and a "plurality of terminal devices interfaced to said distribution network" [160] (Para. [0038] – [0041]). The "network headend" through a "distribution network" [120] "transmits at least one information stream

to a plurality of users" wherein "said information stream" is "comprised of a plurality of information selections" corresponding to interactive commercials (Para. [0046]) and a plurality of corresponding codes . . . identifying a characteristic of a corresponding one of said selections that is employed to identify a system user to whom additional information related to said selection" such as additional information corresponding to a particular coupon offer "should be transmitted" (Para. [0025] and [0052]). The "plurality of terminal devices" [160] comprising a " terminal processor" and a "user demographic database that contains demographic information about a corresponding user of said terminal device" and upon receiving the aforementioned "information stream with said codes", "compares each code for each selection in said information stream with said demographic information in said database and determine[s] . . . whether said user is designated to receive said additional information related to said selection" and "provides a prompt [being embedded in said information stream] to said user designated to receive said additional information" (Figures 2, 3, and 5; Para. [0042] – [0044], [0051] – [0055], [0080] and [0081]).

Claims 2, 15, and 25 are rejected wherein "said headend further includes an encoder" in accordance with the MPEG-2 standard for "generating said codes and inserting said codes into said information stream one each before a corresponding one of said selection" (Para. [0003] and [0006]).

Claims 3 and 16 are rejected wherein "said information stream is a video information stream, said broadcast distribution system is a cable television distribution system, and said terminal devices are each a set top converter box" (Para. [0041] – [0044])

Claims 4 and 17 are rejected wherein the "said information selections includes advertisements" such as broadcast commercials (Para. [0046] and [0081]).

Claims 6 and 19 are rejected wherein the "headend" further comprises a "database containing said additional information that is to be made available to selected system users, based on the demographic information in the user demographic database" [150] (Para. [0040], [0046], and [0079]).

Claim 18 is rejected wherein the "terminal processor is further programmed to provide a prompt to a corresponding user if said processor determines that said user is designated to receive said additional information" (Figure 5; Para. [0045] and [0048]).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 14, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sitnik (US Pat No. 6,160,570) in view of Mao et al. (US Pat No. 6,886,178).

In consideration of claims 1 and 14, the Sitnik reference discloses a "system" and "method for transmitting information in a broadcast distribution system that is targeted to a system user" (Abstract). The system comprises a "network headend" [4], a "distribution network" [5/6], and a "plurality of terminal devices interfaced to said distribution network" [2] (Figure 1). The "network headend" through a "distribution network" [5/6] "transmits at least one information stream to a plurality of users" wherein "said information stream" is "comprised of a plurality of information selections and a plurality of corresponding codes . . . identifying a characteristic of a corresponding one of said selections that is employed to identify a system user to whom additional information should be transmitted" (Col 3, Line 34 – Col 4, Line 34). The "plurality of terminal devices" [2], as illustrated in Figure 2, comprises a " terminal processor" [19] and a "user demographic database that contains demographic information about a corresponding user of said terminal device" [22] (Col 6, Line 34-43; Col 7, Line 41 – Col 8, Line 18). Upon receiving the aforementioned "information stream with said codes", the "terminal processor" [19] "compares each code for each selection in said information stream with said demographic information in said database and determine[s] . . . whether said user is designated to receive said additional information related to said selection" (Figure 3; Col 8, Line 19 – Col 9, Line 56).

While the reference discloses the particular selection of advertisements or commercials from the information stream, the reference is silent with respect to the "terminal processor further being programmed to provide a prompt [being embedded in said information stream]

to said user designated to receive said additional information". For example, the reference is silent with respect to the particular selected or targeted commercials further being enhanced such that the particular presentation of a particular commercial further serves to select or designate the presentation of content associated therewith. In a related art pertaining to video distribution, the Mao et al. reference discloses a "terminal processor" [38/40] being "programmed to provide a prompt [embedded in said information stream] to said user designated to receive said additional information" (Col 1, Line 61-67; Col 4, Line 42 – Col 5, Line 18). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify Sitnik such that the "terminal processor [is] further programmed to provide a prompt [being embedded in said information stream] to said user designated to receive said additional information" as taught by Mao et al. for the purpose of advantageously providing a means by which the user can access additional information related to a particular advertisement in a manner that facilitates quick response time and allows for large numbers of simultaneous requests (Mao et al.: Col 2, Line 47 – Col 3, Line 17).

Claim 29 is rejected wherein the "user demographic database" [22] is "adapted to be private to said terminal device and not shared with said network headend and said distribution unit" in light of the embodiments wherein the profile is generated through an on-screen questionnaire or based upon passive monitoring and the advertisement selection is performed entirely locally such that it need not be nor is disclosed as being accessible to the public at large (Sitnik et al.: Col 7, Line 66 – Col 8, Line 18).

Claim 30 is rejected wherein the aforementioned "prompt" comprises an "icon" (Mao et al.: Col 1, Lines 61-67) and wherein the "additional information is broadcast on a carousel basis over a dedicated channel on said distribution network to said plurality of users" (Figure 5; Col 4, Lines 41-51; Col 8, Lines 5-44) wherein "access to said additional information is only obtainable by said system user designated to receive said additional information and whom requests said additional information in response to said prompt" in light of the combined references. For example, only those users which view a particular advertisement will be able to subsequently access the displayed prompt associated with that advertisement and subsequently obtain the particular information for display.

8. Claim 5 is rejected under 35 U.S.C. 102(a) as being anticipated by Maillard et al (EP 963 119 A1) in view of Dureau (US Pat No. 6,345,389 B1).

In consideration of claim 5, the Maillard et al. reference discloses that the particular interactive application is operable to support a number of services including those wherein the user may be required to provide address information associated with mailing (Para. [0046] and [0076]), but is silent with respect to the aforementioned "prompt comprising a voice prompt". In a related art pertaining to interactive video distribution systems, the Dureau et al. discloses the particular usage of interactive applications wherein the "prompt comprises a voice prompt" (Col 5, Lines 49-67; Col 10, Line 46 – Col 11, Line 3). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify Maillard et al. such that the "prompt is a voice prompt" for the purpose of providing a a simplified and means for the user enter textual information without requiring the usage of a keyboard (Dureau: Col 2, Lines 9-24).

9. Claims 7-12 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maillard et al (EP 963 119 A1) in view of Wachob (US Pat No. 5,155,591).

With respect to claims 7 and 20, the Maillard et al. reference fails to particularly disclose or suggest the further targeting of "information selections" or commercials. Wachob et al. discloses a system and method for providing targeted television commercials. The system comprises a "headend [that] includes a multiplexer" [72] for "simultaneously transmitting a plurality of said information streams on a plurality of corresponding downstream channels that are interfaced between said distribution network and said terminal devices, [wherein] each said information streams includes information selections that are targeted to different user demographics". Each "terminal processor . . . is programmed to determine a selected one of said downstream channels on which a selected information selection targeted to a user of said terminal device is to be received and accesses said selected information selection" (Figure 3; Col 6, Line 27 – Col 7, Line 12). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify Maillard et al. as taught by Wachob for the purpose of advantageously targeting specific commercial advertisements or "information selections" to demographically selected audiences (Wachob: Col 1, Lines 25-30).

Claims 8, 9, 21, and 22 are rejected wherein the "terminal device" [10] of Wachob further comprises a "tuner for selecting a one of said downstream channels to receive" [18] and the "terminal processor" [30] is "further programmed to instruct said tuner to tune to said selected one of said downstream channels to receive said selected information selection" and to "instruct said tuner to tune to back to a previously selected channel after a designated one

of said selections has been received" (Wachob: Figure 3; Col 6, Lines 47-68; Col 7, Lines 13-54).

Claims 10 and 23 is rejected wherein the "information streams include at least one group of information selections, each selection of which is simultaneously transmitted with the other selections in said group, and is targeted to users having different demographics than those of users to which the other selections in said group are targeted" (Wachob: Col 9, Line 20 – Col 10, Line 9; Col 10, Line 43 – Col 11, Line 8).

Claim 11 is rejected wherein the "headend further includes an insertion module for inserting said groups of information selections into said information streams" [60] (Wachob: Col 9, Lines 20-56).

Claim 12 is rejected wherein "each information selection in said groups comprises an advertisement" (Wachob: Col 4, Lines 26-55).

10. Claims 13 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maillard et al (EP 963 119 A1), in view of Wachob (US Pat No. 5,155,591), in further view of Bryant et al. (US Pat No. 5,652,615).

In consideration of claims 13 and 24, the combined references reference does not explicitly disclose nor preclude the usage of digital distribution techniques wherein "each information selection" or commercial is "transmitted in a different PID of a common digital channel". The Bryant et al. reference discloses a method for delivering targeting advertising wherein "each information selection is transmitted in a different PID of a common digital channel" (Col 5, Line 41 – Col 7, Line 17). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify the

Wachob targeted advertisement distribution for the purpose of providing a means to distribute targeted advertisements in conjunction with an upgraded (ex. analog-to-digital) distribution network (Bryant et al.: Col 1, Line 55 – Col 2, Line 14). The particular usage of digital distribution techniques as opposed to analog further provides the commonly known advantage of enabling cable distributors to carry larger numbers of programming due to more efficient utilization of bandwidth. Furthermore, the particular usage of MPEG based distribution in conjunction with Wachob would further advantageously provide for the distribution of a greater number of commercials, hence more precisely targeted advertisements.

Allowable Subject Matter

11. Claims 26-28 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The art of record either alone or in combination fails to disclose or suggest that "each of the plurality of advertisements compris[es] a continuous stream of I-frames for a predetermined amount of time at the beginning and end of each advertisement" as set forth in applicant's arguments of 06 June 2005. The art of record provides evidence as to the particular usage of I-frames starting and ending advertisements in connection with splicing (ex. Pico et al.) and provides evidence that it is known to provide continuous streams of I-frames for the presentation of enhanced content (ex. Bisdikian et al.). It is further commonly known in the art that the particular rate at which I-frames are inserted into an MPEG stream decreases acquisition latency. However, it is the examiner's position that the art of record taken as a

whole would not have suggested the specific usage of I-frames as claimed without engaging in impermissible hindsight.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Kikinis (US Pat No. 5,929,849) reference discloses a system and method for the integration of universal resource locators with television presentations.
- The Kitsukawa et al. (US Pat No. 6,282,713) reference discloses an on-demand advertising information system.
- The Bisdikian et al. (US Pat No. 6,047,317) reference discloses a system for distributing continuous I-frames for interactive content.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to

37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 571-272-7343. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott Beliveau
Examiner
Art Unit 2614

SEB
January 10, 2006